

REMARKS

The Final Office Action of March 18, 2004, and the prior art relied upon therein have been carefully reviewed. Upon entry of the amendment submitted above, the claims in the application will be only claims 1-14, and these claims define patentable subject matter warranting their allowance. Accordingly, applicants respectfully request favorable reconsideration, entry of the amendment above, and allowance.

Claims 16 and 17 have been rejected as obvious over certain prior art. Applicants have proposed above to delete claims 16 and 17, without prejudice, whereby such rejection need not be addressed at the present time.

As with all of applicants' amendments proposed above, applicants make these amendments without prejudice to applicants' rights, including those rights provided by §§120 and 119, to pursue any subject matter given up by such amendments in a continuing application, if applicants choose to do so.

Claims 1, 2, 4-7, 16 and 18 have been rejected under §102 as anticipated by Ueno '163. This rejection is respectfully traversed.

First, as regards claims 16 and 18, these have been deleted without prejudice, applicants respectfully repeating by reference the comments made above.

The rejection states that comparative example 1 in column 14 of Ueno discloses the use of a compound embraced by the language of formula 1 of the claims (including the compound of chemical formula 11 on page 17). However, this is not correct. The compound represented by formula (V) in Ueno at column 14 differs significantly from the compound represented by Chemical Formula 11 (page 17) of the instant application in the following respects:

i) the compound of formula (V) has both indolenin skeleton and indan skeleton, while the compound of applicants' Chemical Formula 11 has the indolenin skeleton only;

ii) the compound of formula (V) has "Cl" atoms as substituents bound to benzene rings, while the compound of Chemical Formula 11 has "NO<sub>2</sub>" groups as substituents bound to benzene rings; and

iii) the compound of formula (V) has "CH<sub>3</sub> groups as substituents bound to N atom in indolenine skeleton and C atom in indan skeleton, while the compound of Chemical Formula 11 has "C<sub>4</sub>H<sub>9</sub>" groups as substituents bound to N atom in both indolenine skeletons.

There is no anticipation, and no prima facie obviousness.

Compound No. 21 in Table 2 of Ueno also differs from the compound of Chemical Formula 34 (page 24) of the instant application in the following respects:

i) compound No. 21 is a metal chelate and has no ligand, while applicants' compound of Chemical Formula 34 is a complex and has a ligand; and

ii) compound No. 21 possesses an "OH" group as a substituent of Y, whereas applicants' compound of Chemical Formula 34 has an "O<sup>-</sup>", i.e. acid base, at the position corresponding to Y.

Again, there is no anticipation, and no obviousness.

The examiner also states that the compounds used in the sample of Table 4 of Ueno are embraced by formula 3 of claim 4. However, it should be noted that claim 4 refers to an organic dye compound which is a metal complex of an azo compound represented by Formula 3. Ueno does not disclose anything about an organic dye compound which in the form of a metal complex of an azo compound represented by Formula 3.

In view of above, it should be clear that Ueno does not disclose the same compound as claimed in claims 1, 2, and 4-7 of the instant application.

Furthermore, as recited in the amended claim 1, one of the features of the claimed invention is to use the specific organic dye compounds in combination with one or more members selected from the group consisting of nitroso compounds and metal complexes in the specified amount ratio. The advantages of this feature are described in applicants' specification at page 28, first paragraph. Ueno discloses nothing about this feature.

Also, claim 4 depends from and incorporates the subject matter of claim 1.

It is therefore submitted that claims 1, 2 and 4-7 are not anticipated by Ueno '163. Applicants respectfully request withdrawal of the rejection.

Claims 1 and 5-9 have also been rejected under §102 as anticipated by Namba '231. This rejection is also respectfully traversed.

Consistent with the previously pending claims, claim 1 is proposed to be amended above to specify that the organic dye compounds are used in combination with one or more members selected from the group consisting of nitroso compounds and metal complexes in the specified amount ratio. Namba does not disclose an optical recording medium as so recited.

Applicants respectfully request withdrawal of the rejection.

Claims 1, 2, 5-9, 12-14 and 16 have been rejected under §103 as obvious from Namba '231. This rejection is respectfully traversed.

The rejection is based on the allegation that it would have been obvious to do something which the reference does not teach or suggest. Respectfully, where does the person of ordinary skill in the art obtain the motive or incentive, the reason or purpose for modifying Namba to achieve what is recited in applicants' claims? How does the rejection comply with MPEP 2143.03 that all words appearing in the claims must be taught or suggested. Respectfully, where are all the requirements set forth in the first paragraph of MPEP 2143?

Respectfully, the initial burden is on the PTO. The PTO must support its rejections with evidence, which evidence is usually in the form of some teaching in a reference. There is nothing in Namba which teaches or suggests the changes proposed in Namba to reach applicants' claimed subject matter.

Applicants respectfully request withdrawal of the rejection.

Claims 1, 5-9, 13 and 14 have been rejected under §102 as anticipated by Nanba JP '396. This rejection is respectfully traversed.

As indicated above, applicants propose an amendment to claim 1 consistent with previously claimed subject matter. Upon entry of the amendment to claim 1, it should be clear that Nanba JP '396 does not anticipate any of applicants' claims.

Accordingly, applicants respectfully request withdrawal of this rejection.

Claims 1, 2, 5-9, 12-14 and 16 have been rejected as obvious under §103 from Nanba JP '396. This rejection is also respectfully traversed.

First, as with all the repeated rejections, applicants do not here repeat the arguments previously made, but also do not abandon those arguments. Applicants are not laboring under the illusion that the claims in question are method of use claims. Applicants respectfully note in this regard that any recitation in a claim which serves to define the claimed subject matter is not to be ignored in properly evaluating the patentability of that claim.

Moving on, applicants have pointed out above why Nanba JP '396 does not anticipate applicants' claims. Nanba also does not make obvious applicants' claims because there is no teaching or suggestion, motive or incentive, reason or purpose provided in the prior art for changing Nanba to reach the subject matter of applicants' claims. Applicants

respectfully repeat by reference the comments made above in response to the obviousness rejection based on Namba '231, applicants again respectfully noting that the initial burden is on the PTO, and this burden has not been met.

Applicants respectfully request withdrawal of the rejection.

Claims 1, 5-9 and 12-14 have been rejected under §102 as anticipated by Umehara JP '408. This rejection is respectfully traversed, again in part for reasons set forth in the last Reply.

Applicants again respectfully note the amendment proposed above for claims 1 and 8 which adds further distinctions over the prior art.

The rejection should be withdrawn. Such is respectfully requested.

Claims 1, 2, 5-9, 12-14 and 16 have been rejected under §102 as anticipated by Aihara EP '751. This rejection is respectfully traversed, applicants again repeating by reference their commentary on this rejection from the preceding Reply.

Regardless, the feature added above to claim 1 further distinguishes claim 1 from the prior art. The

rejection should be withdrawn, and such is respectfully requested.

Claims 1, 4-7 and 18 have been rejected under §102 as anticipated by Suzuki '519. This rejection is again respectfully traversed, applicants continuing to rely on the Remarks of the preceding Reply.

Applicants do not see that the PTO has answered or rebutted applicants' arguments of the preceding Reply, e.g. recitation of an absorption maximum is a characteristic feature and thus serves to define the claimed subject matter, such recitations in the claims being fully proper and defining of the invention.

Nevertheless, applicants move on and refer to the amendments proposed above, which further define over Suzuki (as well as the other applied prior art). Accordingly, applicants respectfully request withdrawal of the rejection.

Claims 1, 3, 5-7 and 17 have been again rejected under §102 as anticipated by Kanno GB '751. This rejection is again respectfully traversed for the reasons set forth in the preceding Reply.

Nevertheless, moving on, applicants now rely on the further distinction proposed above to be added to claim 1,



which further serves to distinguish applicants' claims from Kanno.

Applicants respectfully request withdrawal of the rejection.

Claims 1, 4-8, 11-15 and 18 have been rejected under §102 as anticipated Yoshikawa. This rejection is respectfully traversed, applicants respectfully repeating by reference the Remarks of the preceding Reply.

Nevertheless, applicants move on and now further rely on the features proposed to be added to claims 1 and 8 above. Applicants' claims are not anticipated by Yoshikawa.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 1, 2, 5-7 and 16 have been rejected under §102 as anticipated by JP 03-032884 (newly cited reference O). This rejection is respectfully traversed.

Applicants have studied this citation and found that it does not disclose the features of the claimed invention, and in particular the feature as recited in amended claim 1. Accordingly, applicants respectfully request withdrawal of this rejection.

Claims 1, 2, 5-7 and 16 have been rejected as obvious under §103 from newly cited applied JP '9884. This rejection is respectfully traversed.

Applicants have also studied this citation and similarly found that it does not disclose the features of the claimed invention, and in particular the feature as recited in amended claim 1.

Thus, even if it were obvious (not conceded; applicants respectfully repeat by reference the arguments made above with respect to other obviousness rejections), the modified JP '9884 would not reach the claimed subject matter.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 1, 2, 5-7 and 16 have been rejected under §102 as anticipated by newly cited and applied JP '388. This rejection is respectfully traversed.

Applicants have studied this citation and found that it also does not disclose the features of the claimed invention, and in particular the added feature as recited in amended claim 1.

Accordingly, applicants respectfully request withdrawal of this rejection.

Claims 1, 2, 5-7 and 16 have been rejected as obvious under §103 from JP '388. This rejection is respectfully traversed.

Applicants have pointed out above why JP '388 does not anticipate applicants' claims, and apparently the examiner agrees because this rejection takes the inconsistent position of saying that the subject matter is obvious from the same reference also applied under §102. Clearly, the reference cannot both anticipate the claims and make such claims obvious. It has to be one or the other, but in this case is neither.

There is nothing in the prior art which teaches one of ordinary skill in the art how to modify JP '388 to reach applicants' claimed subject matter. Accordingly, the rejection should be withdrawn and such is respectfully requested.

Claims 1, 2, 5-7 and 16 have been rejected as obvious under §103 from newly cited and applied JP '434. This rejection is respectfully traversed.

Applicants agree that JP '434 does **not** anticipate applicants' claims. The amendments proposed above to claim 1 take applicants' subject matter even farther away from JP '434. There is nothing in the prior art which would teach the

person of ordinary skill in the art how to modify JP '434 to reach applicants' claimed subject matter.

Accordingly, the rejection is improper and should be withdrawn. Such is respectfully requested.

Claims 1, 2, 5-7 and 16 have been rejected as obvious under §103 from Saito '089, newly cited and applied. This rejection is respectfully traversed.

Again, applicants agree that this citation does not anticipate any of applicants' claims. Moreover, the amendments proposed for claim 1 above take claim 1 even farther away from Saito. There is nothing in the prior art which would have led the person of ordinary skill in the art to modify Saito so as to reach applicants' claimed subject matter.

The rejection should be withdrawn, and such is respectfully requested.

Claims 1, 2, 5-7 and 16 have been rejected under §102 as anticipated by newly cited and applied Huditch '584. This rejection is respectfully traversed.

Applicants have studied this citation and found that it, like the other newly applied references, does not disclose the features of the claimed invention, and in particular the

feature as recited in amended claim 1. Accordingly,  
applicants respectfully request withdrawal of this rejection.

On top of the many cumulative rejections responded  
to above, claims 1-14 and 16-18 have further been rejected as  
obvious under §103 from "any of the above cited references, in  
view of Namba... '231". These multiple rejections are  
respectfully traversed.

For the reasons pointed above, the "primary"  
reference do not show or make obvious the subject matter of  
applicants' claims as proposed to be amended above. Namba  
'231 does not make up for the deficiencies of the primary  
references, and has not even been cited for that purpose.  
Therefore, even if the combinations as proposed were obvious,  
respectfully not conceded by applicants, the resultant  
combinations would not reach applicants' claims.

Applicants respectfully request withdrawal of the  
multiple rejections.

Claims 1-3, 5-10, 12-14, 16 and 17 have been  
rejected as obvious under §103 from various combinations (as  
understood) of four (4) references in combination, the  
quaternary reference in each case being selected from six (6)  
different citations. These six combination rejections are  
respectfully traversed.

None of the prior art relied upon, in any possible combination, shows the features proposed to be added to claims 1 and 8. Therefore, even if the combinations were obvious, respectfully denied, they would not reach the claimed subject matter.

Applicants respectfully request that these rejections be withdrawn.

Applicants raised a serious question in the preceding Reply concerning the cumulative rejections, clearly prohibited by MPEP 706.02. The examiner has not only ignored applicants' serious concerns, but has also exacerbated the situation by making even more cumulative rejections. Applicants simply do not understand why the examiner has chosen to so proceed contrary to the Manual of Patent Examining Procedure. Applicants believe that by creating such an onerous situation for applicants, the examiner has acted unfairly.

Applicants further note that the examiner has cited and applied new prior art, not necessitated by any amendments presented in the last Reply. That these new citations were not necessary is evidenced by the fact that the examiner has repeated most of the previous rejections. Accordingly, as the citation and application of new prior art was not necessitated by any of applicants' amendments, **the finality of this last**

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Office Action was premature and should be withdrawn. Such is respectfully requested.

Applicants again respectfully request favorable reconsideration, entry of the amendments presented above, and formal allowance; and, if the claims are not allowed, applicants request withdrawal of the finality of the last Office Action as premature for the reasons pointed out immediately above, whereby the amendments presented above will be entered as a matter of right.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.  
Attorneys for Applicant(s)

By



Sheridan Weimark  
Registration No. 20,520

SN:jaa  
Telephone No.: (202) 628-5197  
Facsimile No.: (202) 737-3528  
G:\BN\S\SUMA\MATSUI 5\pto\Amd 25au04.doc